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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,481	08/01/2001	Dawn Carey	J1-2-1-A-US	5566

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SoCAL IP LAW GROUP LLP
310 N. WESTLAKE BLVD. STE 120
WESTLAKE VILLAGE, CA 91362

EXAMINER

OSBORNE, LUKE R

ART UNIT	PAPER NUMBER
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2123

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,481

Applicant(s)

CAREY, DAWN

Examiner

Luke Osborne

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/15/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30,40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30,40 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/13/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Status

1. Claims 1-30, 40 and 41 have been presented for reconsideration. Claims 31-39 have been cancelled. Claims 1-30, 40 and 41 are now pending in the instant application.
2. Applicants' arguments submitted 6/15/2005 2:43:07 have been fully considered, Examiners response is as follows. Applicants' response 6/15/2005 1:54:42 have been disregarded due to the duplicate nature of the amendments, and the lack of a signature on the notice of transmittal. Any further reference to the response submitted on 6/15/2005 will be referring to the 2:43:07 transmission.

Information Disclosure Statement

The information disclosure statement filed 5/13/20005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. There is no provided copy of Haitsuka EP 1083504A2 consequently it has not been considered.

Specification

3. Examiner acknowledges the amendment to the Specification regarding trademarks. Consequently the objection is withdrawn.

Claim Objections

4. Examiner acknowledges the amendment to claim 12 regarding the informality. Consequently the objection is withdrawn.

5. Examiner acknowledges the cancellation of claims 31-39 regarding the duplication issue. Consequently the Advisement is withdrawn.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-2, 4-6, 13-14, 16-18, 22-23, 25-27, 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gifford of record in view of Talati.

Regarding claim 1, Gifford teaches a method of delivering items of content from a storage location to client devices at remote locations through e-mail based inquiry-response automation. See Figures 1, 6, 7, 14, 16 and the corresponding portions of Gifford's specification for this disclosure. In particular, Gifford teaches A method of

delivering items of content from a storage location [Figure 1, item 65] to client devices at remote locations [Figure 1] through an e-mail based inquiry-response automation, the method comprising the steps of

- Providing a content delivery system for customer support
- storing plural items of content, wherein the plural items of content are selected from the group comprising a technical support information and a product data sheet [Figure 1, item 65, Figure 2, Column 4, lines 43-51]
- storing respective descriptions of the items of content and respective order codes for the items of content [Figure 1, item 65, Figure 2, Column 4, lines 52-55]
- receiving a first message via e-mail [system can implement an electronic mail order system (Column 7, lines 9-10)] from a user of a given client device at a remote location, whereby an inquiry-response transaction is initiated [Figure 6, items 19-20]
- responding via e-mail to the first e-mail message with a prompt message item, the prompt e-mail message including an arrangement of descriptions and order codes for a plurality of the items of content and instructions to the user for ordering the items of content [Figure 6, item 22, 23, 24, Column 5, lines 18-28]
- parsing the second e-mail message for at least one of the order codes specified by the user [Figure 6, item 25]
- extracting the items of content identified by the order codes in the second e-mail message [Figure 6, item 30]

- packaging the items of content from the extracting step into a single package unit [Figure 6, item 30]
- responding via e-mail to the second e-mail message with a response e-mail message comprising the single package unit comprising the items of content corresponding to the order in the second e-mail message [Figure 6, item 31].

Gifford does not expressly teach assigning a tracking code for the e-mail based inquiry-response transaction or parsing the second e-mail message and identifying the tracking code in the second e-mail message.

Talati discloses a method similar to Gifford providing for an online system for electronic commerce. See Figures 1 and 2 and the corresponding portions of Talati's specification for this disclosure. In particular, Talati uses a Unique Global Transaction ID (UTID) in order to help identify the originator (user) [Column 4, lines 49-51, Figure 12, item 331]. Talati also teaches "the use of the UTID in all communications" Talati Column 6, lines 44-52.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the UTID tracking code of Talati with the online transaction system of Gifford.

The motivation for doing so would have been to reduce fraudulent transactions as evidenced by Talati Column 6, lines 44-52.

Applicant Primarily Argues

Claim 1 has been amended. In current form, claim 1 is patentable over Gifford in view of Talati.

Examiners Response

Examiner finds Applicants' argument unpersuasive.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Regarding claim 2, Gifford in view of Talati teaches the method of delivering items of content from a storage location to client devices at remote locations through e-mail based inquiry-response automation of claim 1. In particular, the combination teaches further comprising, after the step of parsing the second e-mail message for at least one of the order codes, if the second e-mail message does not have at least one order code specified by the user [Gifford: Figure 7, item 33], then responding via e-mail to the second e-mail message with a simpler prompt message [Gifford: Figure 7, item

34], the simpler prompt e-mail message including the arrangement of descriptions and order codes for a plurality of the items of content, the tracking code, and simpler instructions to the user for ordering the items of content [Gifford: Column 7, lines 30-49].

Applicant Primarily Argues

In response to the limitation “if the second e-mail message does not have at least one order code specified by the user, then responding via e-mail to the second e-mail message with a simpler prompt message.” Gifford’s missing payment form 33 is presented only after the user has selected a link to purchase a document.

Examiners Response

Examiner finds Applicants’ arguments unpersuasive. In response to the missing information a simpler [having few parts; not complex or complicated or involved] prompt is sent back to the user if the information required is missing.

Regarding claim 4, Gifford in view of Talati teaches the method of delivering items of content from a storage location to client devices at remote locations through e-mail based inquiry-response automation of claim 1. In particular, wherein the response e-mail message includes the tracking code [Talati: Column 6, lines 44-52].

Regarding claims 5 and 6, Gifford in view of Talati teaches the method of delivering items of content from a storage location to client devices at remote locations through e-mail based inquiry-response automation of claim 1.

The combination as applied to claim 1 does not teach storing the first and second e-mails. However, Talati further teaches storing the first e-mail and second e-mail messages as shown in Talati: Figure 11, item 315 and 330.

At the time of the invention it would have been obvious to one of ordinary skill in the art, to use the e-mail database of Talati with the e-commerce system of Gifford.

The motivation for doing so would have been to keep a record of the transactions and to determine the format of the email as evidenced by Talati Column 8, lines 47-61.

Claims 13-14, 16-18, and 22-23, 25-27 refer to the system for method claims 1-6 thus are rejected for the same reasons as claims 1-2, 4-6.

Claim 40 refers to the system of claims 13, thus is rejected for the same reasons as claim 13.

Claim 41 refers to the method of claims 1, thus is rejected for the same reasons as claim 1.

7. Claims 3, 15 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gifford of record in view of Talati of record, further in view of Applicant Admitted Prior Art (AAPA) at paragraph [0004].

Regarding claim 3, Gifford in view of Talati in view of AAPA teaches the method of delivering items of content from a storage location to client devices at remote locations through e-mail based inquiry-response automation of claim 2. In particular, further comprising receiving a third message via e-mail from the user [Gifford : Figure 6, item 21] parsing the third e-mail message and identifying the tracking code in the third e-mail message [Talati Column 6, lines 44-52] parsing the third e-mail message for at least one of the order codes specified by the user if the third e-mail message has at least one order code specified by the user, then extracting the items of content identified by the order codes in the second e-mail message packaging the items of content from the extracting step into a single package unit responding via e-mail to the second e-mail message with a response e-mail message comprising the single package unit comprising the items of content corresponding to the order codes in the second e-mail message [Gifford: Figure 6,7].

Gifford in view of Talati does not teach if the third e-mail message does not have at least one order code specified by the user, then referring the third e-mail message to a human specialist at a client device.

However as applicant's admits in paragraph [0004] that "In the past, telephone operators and support staff have typically been required to retrieve the information requests.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made, in combination with applicant's knowledge of the art to, refer to

a human specialist when the automation of the process reached an impasse, i.e. if the third e-mail message does not have at least one order code specified by the user.

The suggestion for doing so would have been to make the process faster, and more efficient, and cost less, as Applicant suggests in paragraph [0004]

Applicant Primarily Argues

The limitation of "receiving a third message via e-mail from the user" is not taught by the references cited.

Examiners Response

Examiner finds Applicants' arguments unpersuasive. Gifford's invention is drawn to an e-mail system [In this way the network sales system can implement an electronic mail order system]. The rejection is maintained.

Claims 15, 24 refer to the system for method claim 3 thus, are rejected for the same reasons as claim 3.

8. Claims 7, 19 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gifford in view of Talati of record, further in view of Applicant Admitted Prior Art (AAPA) at paragraphs [0003]-[0004].

Regarding claim 7, Gifford in view of Talati teaches the method of delivering items of content from a storage location to client devices at remote locations through e-

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mail based inquiry-response automation of claim 1. Gifford's transactions are for information documents.

The combination does not teach that the items of content comprise technical support documents the descriptions of the items of content comprise common technical support questions which are answered by the respective technical support documents.

However as Applicant admits in Paragraph 0003 "the information itself may take any form including technical support, advertisements, data sheets, notices, etc."

Therefore it would have been obvious to a person of ordinary skill in the art at the time of applicants invention to use the automated reply system as combined for claim 1 with applicants admission of what information can be used.

The motivation to do so would have been, automation as known in the art

Applicant's arguments with respect to claim 7 have been considered but are moot in view of the new ground(s) of rejection.

Claims 19, 28 refer to the system for method claim 7 thus, are rejected for the same reasons as claims 7.

9. Claims 8 – 12, 20-21 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gifford in view of Talati of record as applied to claim 1 above, and further in view of Schuster of record.

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Claims 8 and 9 are directed to assigning status codes to the e-mail for tracking purposes. The combination of Gifford in view of Talati as applied to claim 1 does not expressly teach such status codes.

Schuster teaches using status codes with e-mail [Schuster: STATUS CODE 350].

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to combine the status codes of Schuster with the e-mail ecommerce combination as applied to claim 1.

The motivation for doing so would have been to be able to track the progress of the transaction to be able to pick up at the right place if need be if there were a problem in the system (ie power failure) such motivation is common in the art.

Claims 10 –12 are directed to restricting and restraining access by the users to the items of content in accordance with specified criteria. This criteria being the client's device being able to accept such content, and whether or not the user has chosen to be able to receive such content. The combination of Gifford in view of Talati as applied to claim 1 does not expressly teach such restrictions of access.

Schuster teaches content restriction according to the user's preferences [each dial-up user has a profile (Column 6, lines 43-44)] and the users device [accesses user profile database (UPD) 330 to determine if the originating communication device is recognized as being associated with a user account serviced by the remote access system (Column 7, lines 30-33)].

At the time of the Applicant's invention, it would have been obvious to a person of ordinary skill in the art to use the user profile containing user and device information of Schuster to the e-mail ecommerce combination as applied to claim 1.

The motivation for doing so would have been to only provide content that the device could handle (ie not sending a sound to a device without a speaker), or sending data that the user doesn't want.

Claims 20-21, 29-30 refer to the system for method claims 8-9 thus are rejected for the same reasons as claims 8-9.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

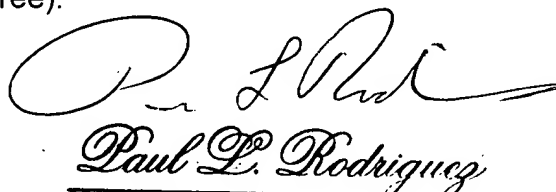
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Osborne whose telephone number is (571) 272-4027. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo P. Picard can be reached on (571) 272-3749. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LRO


Paul L. Rodriguez 8/31/05
Primary Examiner
Art Unit 2125